

Appl. No. 10/707,437
Amdt. dated 27 November 2007
Reply to Office action of 2 May 2007

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Claim 11 is made dependent upon Claim 1, and includes all the limitations of Claim 1.

Support for the amendments to Claims 4, 6, and 8 comes from paragraphs 0047, 0048, 0059, 0060, 0061, 0064, 0066, and elsewhere in the original Specification, as well as Figures 3 and 12.

I. CLAIMS 1, 4, 8, 11: CLAIM REJECTION - 35 U.S.C. § 103

The Examiner is required to show one or more references that teach or disclose, at least implicitly (through the nature of the problem solved, for example), elements of present claims, plus a suggestion to combine or modify the references, which, in combination, make the present claims obvious.

The combination must teach or suggest all the claim limitations. "[A] patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art." *KSR International Co. v. Teleflex Inc.*, 550 US ___, 127 S.Ct. 30 (2007). Therefore, the Examiner must make explicit the "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness". *KSR*, quoting *In re Kahn*, 441 F.3d 977 (CA Fed. 2006). Restated, the Examiner must provide a clear, articulable, adequate "reason to combine" the references, through reasoning and/or analysis. 72 Fed. Reg. at 57528 (Oct. 10, 2007).

A.) THE TEACHINGS OF GILLESPIE, IN CONJUNCTION WITH TYNER

The Examiner asserts that Gillespie (US Patent #6,125,032) teaches Claim 1 and 11 and, in conjunction with Tyner (US Patent # 6,644,605), the combination teaches a mousepad with an anchored member.

1.) Claim 1: Gillespie fails to teach a member or member being anchored in the mousepad, and Tyner teaches merely an opening in a dual-density keyboard tray.

The Examiner admits that Gillespie "fails to teach the member or members being anchored in the mouse pad," but asserts that Tyner teaches a mousepad with a hole or "aperture" for receiving a member. However, neither teaches the additional anchoring limitations of Claim 1.

Gillespie, as this Applicant has pointed out in prior responses in this prosecution, is a purely decorative diorama with primarily non-functional elements, who's only function are to make using a computer "decorative" (Gillespie at p. 4, col. 1), "friendly" (Gillespie at p. 4, col. 1), and "fun" (Gillespie at p. 4, col. 1).

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The Examiner's reference to Tyner refers to holes used to mount a paper-holder which is not on the mousepad at all, but which is positioned on the opposite side of a keyboard tray from the mouse. Tyner thus shows a hole which is not on a mousepad and is not for a bumper at the edge of a mousepad.

More specifically, Tyner shows holes in a rigid "support member" (70, which is described in Tyner, p.15, col. 4, as having "adequate rigidity" and being "integrally molded within the interior of the keyboard tray" and "prevent[ing] the keyboard tray from flexing"). Thus, Tyner teaches insertion of a post into a hole in a flexible plastic material and then through a hole in its more rigid internal material, through both density layers.

Moreover, by its own limitation, Tyner shows an "aperture" or "throughholes" for "insertion *and removal*" (Tyner at page 16, col. 6, emphasis added) of posts. Tyner states that the post *should be removable* from the hole.

At best, in combination, the prior art might reveal how one could insert a decorative array's post into the material of a dual-density, semi-rigid mousepad, by sticking posts into a hole in a complex mousepad material.

A decorative diorama, in combination with a paper-holder, can not be seen in combination so as to make the present disclosure obvious. Neither patent has the elements involved in the present disclosure because a "throughhole" or simple post hole in a dual-density material is not the same as creating an anchored bumper from lateral forces when struck by a mouse. There is no evidence in either Gillespie or Tyner that those applicants contemplated solving the problem of a mouse traveling off the edge of a mousepad.

Gillespie sought to put up decorative dioramas, and Tyner sought to stick a paper holder in a keyboard tray.

They deal with purely decorative elements and removable elements, which are not part of a mousepad. Neither deal at all with the problem sought to be solved by the present disclosure: keeping a mouse on the mousepad by anchoring a bumper into a mousepad. There is no reason to combine the references, and, even if combined using 20-20 hindsight, the combination does not get one to the present disclosure.

2.) Claim 11: Gillespie and Tyner fail to teach the use of a mousepad with accessories to be used to play a sport in miniature.

The Examiner did not directly address the limitations of Claim 11 in the First Office Action dated 23 September 2004, the Office Action dated 9 March 2005, or the May 2, 2007, Non-final Office Action.

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The present application teaches the possibility of using the mousepad as a game (see, e.g., paragraphs 53 through 56), or adding additional pieces that could be utilized to play a sport in miniature, using the mousepad.

These elements are novel and reveal an improvement over the prior art, and are, therefore, patentable even without the limitations present in Claim 1.

3.) Claims 4 and 8:

By the same token as Claim 1 above, the arguments of which are herein incorporated, Gillespie plus Tyner fails to disclose elements that would lead a person of ordinary skill in the art to combine these references. Further, the present disclosure solves a different problem than presented in either Gillespie or Tyner.

II. CLAIMS 1 and 6: CLAIM REJECTION - 35 U.S.C. § 102(b)

Section 102 rejections require that a single reference teaches or enables each and every one of the claimed elements, expressly or inherently as interpreted by one of ordinary skill in the art. This type of objection can be overcome by demonstrating the claims are patentably distinguishable from the prior art or by amending the claims to the same end. The Applicant here pursues both avenues.

A. THE TEACHINGS OF THE "INFORMATION FAIRWAY MOUSEPAD" IN VIEW OF TYNER:

The Examiner asserts that the non-patent literature showing a picture, entitled an "Information Fairway Mousepad," teaches a mousepad with one or more connectedly attached members at or near the edge of the mousepad, attached in a roughly perpendicular fashion. Secondly, the examiner asserts that the picture shows a member that provides a barrier to discourage mouse movement off that edge of the pad. The Examiner also asserts that the picture appears to show a golf hole, post, and flag, with the appearance of a partial or full golf green. Lastly, the Examiner asserts that the flag provides area for promotional graphics.

The Examiner admits that the "Information Fairway Mousepad" fails to teach the member or members being anchored in the mousepad.

1.) It is unclear whether the reference predates the filing of this application.

In order to make a rejection under § 102(b), by the terms of the statute, the printed publication must have been made or the item sold, or the item in public use, more than

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one year prior to this application. Axiomatically, it must be *prior* to the present disclosure to be prior art.

It is not clear, from the non-patent literature, when the Information Fairway Mousepad was first advertised or sold. In order to make a *prima facie* case of §102(b) anticipation, the Examiner needs to demonstrate a reasonable basis for the assertion that the relied-upon material pre-dates the present application. The literature is not dated, thus the Examiner has not made the necessary *prima facie* case for rejection.

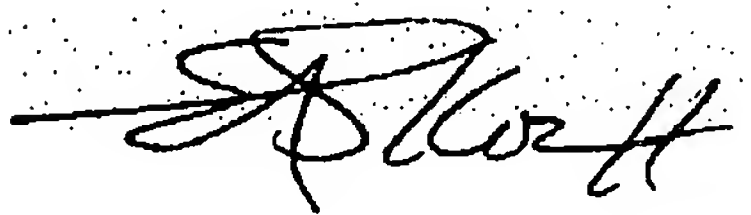
2.) The item pictured does not teach a hole on the golf green and does not teach the further anchoring details present in Claim 1 as amended.

Leaving aside the issue of the date of the publication of the Information Fairway Mousepad advertisement, there is no indication or teaching of a hole on the golf "green" either at the base of the pole or elsewhere on the "green." Further, neither the non-patent literature or Tyner teaches a pole or member having a thickness greater than the thickness of remainder of said post, and said end being flush with an under surface of said mousepad.

CONCLUSION

For the reasons stated above, the Applicant asks that the Examiner enter the amendments contained herein, withdraw her rejections with respect to the claims, and allow the application to issue as a patent.

Thank you,
Sincerely,



Ed Skoch